

REMARKS

Claims 1-20 are amended herein. Claims 1-20 remain in the application. No new matter has been added. Consideration and examination is respectfully requested.

1. ALLOWABLE SUBJECT MATTER (OBJECTION TO CLAIMS 11-20):

In items 5 and 6 on page 5 of the Office Action dated 30 April 2004 (Paper No./Mail Date 0404) referred to hereinafter as the Office Action of 30 April 2004, claims 11-20 were objected to as "being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Applicant respectively traverses the objection. However, to overcome the objection of the Office Action of 20 April 2004, claims 11 and 12 have been rewritten so as to include the limitations of their base claim (claim 1) as written prior to the present Amendment. There were no intervening claims. Thus, Applicant has overcome the objection of the Office Action of 30 April 2004 to claims 11 and 12, and claims 11 and 12 are allowable.

In addition, because dependent claims 13 and 14 each depend from independent claim 12 which is allowable, it follows that Applicant has overcome the objection of the Office Action of 30 April 2004 to claims 13 and 14 and that dependent claims 13 and 14 are also allowable.

Because dependent claims 15, 17, 19, and 20 each depend from independent claim 12 via dependent claim 14, both of which are allowable, it follows that Applicant has overcome the objection of the Office Action of 30 April 2004 to claims 15, 17, 19, and 20 and that dependent claims 15, 17, 19, and 20 are also allowable.

Because dependent claim 16 depends from independent claim 12 via dependent claims 15 and 14, both of which are allowable, it follows that Applicant has overcome the objection of the Office Action of 30 April 2004 to claim 16 and that dependent claim 16 is also allowable.

Because dependent claim 18 depends from independent claim 12 via dependent claims 17 and 14, both of which are allowable, it follows that Applicant has overcome the objection of the Office Action of 30 April 2004 to claim 18 and that dependent claim 18 is

also allowable.

2. REJECTION OF CLAIMS 1-7 & 9-10 UNDER U.S.C. § 102(b):

In item 2 on page 2 of the Office Action of 30 April 2004, claims 1-7 and 9-10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Huang in U.S. Patent Number 6,091,253 entitled "Jig for Electrically Bridging Between a Circuit Board and a Tester During Testing of the Circuit Board" hereinafter *Huang*. Applicant respectfully traverses.

As stated in MPEP 2131 "To anticipate a claim, the reference must teach every element of the claim." As will be shown in the following paragraphs, *Huang* fails to teach every element of claims 1-7 and 9-10.

Regarding Rejection of Independent Claim 1 Under 35 U.S.C. § 102(b):

Among other items, *Huang* does not disclose "multiple alignment pins imbedded in the housing and extending external to both first and second sides" which is an element of claim 1 of the Present Application. In the last paragraph of the Office Action of 30 April 2004 it is alleged that in *Huang* "(414, 211P2, the pins 211P2 is extending from the surface of electronic probe 200 into the guide holes 411 and to hole 11, therefore it is embedded in housing 400)". Referring to The American Heritage College Dictionary (Third Edition): Houghton Mifflin Company, Boston, page 448 (1993) (See Exhibit A), the first definition of the verb embed (variation: embed) is "to fix firmly in a surrounding mass; *to embed a post in concrete*" and the third definition is "To cause to be an integral part of a surrounding whole." Note, for example, that in the Present Application in lines 17-19 on page 7 the pins are imbedded as follows: "In the representative embodiment of Figure 3A, the alignment/retention device 110 is shown with four alignment pins 180 molded into the housing 155 of the alignment/retention device 110 ... ". The pins do NOT move within the housing, they are imbedded as defined in Exhibit A and as used in claim 1 of the Present Application. The Office Action of 30 April 2004 incorrectly uses the verb embed to mean sliding pins into holes. A pin free to slide within a hole is not the same as a pin being imbedded in or integrally a part of a housing.

Thus, Applicant has demonstrated that *Huang* fails to teach every element of claim 1. Because *Huang* fails to teach every element of claim 1 as required by MPEP 2131, *Huang* does not anticipate claim 1. In addition, *Huang* fails to suggest every element of claim 1.

Thus, claim 1 is allowable over *Huang*.

Regarding Rejection of Dependent Claims 2-7 & 9-10 Under 35 U.S.C. § 102(b):

Because dependent claims 2-7 and 9-10 depend from independent claim 1, it is noted that dependent claims 2-7 and 9-10 have all the features described above for independent claim 1 as elements. As demonstrated above, independent claim 1 is not anticipated by *Huang*, nor does *Huang* suggest every element of claim 1.

Thus, claims 2-7 and 9-10 are not anticipated by *Huang*, nor does *Huang* suggest every element in each of claims 2-7 and 9-10, and it follows that claims 2-7 and 9-10 are allowable over *Huang*.

3. REJECTION OF CLAIM 8 UNDER 35 U.S.C. § 103(a):

In item 4 on page 4 of the Office Action of 30 April 2004, claim 8 was rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Huang*. Applicant respectfully traverses.

Referring to MPEP 2142, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Regarding Rejection of Claims 8 Under 35 U.S.C. § 103(a):

With respect to the rejection of claim 8 under 35 U.S.C. § 103(a), it is noted that dependent claim 8 depends from independent claim 1 via claim 7 and that, as such, dependent claim 8 has all the features described above for claim 1 as elements. As demonstrated above, among other items, *Huang* does not disclose "multiple alignment pins imbedded in the

housing and extending external to both first and second sides" which is an element of claim 1 of the Present Application.

Thus, the cited reference does not teach nor does it suggest all the claim limitations of claim 8 as required by MPEP 2142. As such, claim 8 is not obvious over *Huang*, and it follows that claim 8 is allowable.

4. IN CONCLUSION:

Entry of this amendment is respectfully requested. Applicant believes that all claims pending in the Present Application as described above are allowable and that all other issues raised by the Examiner have been rectified. Therefore, Applicant respectfully requests the Examiner to reconsider his rejections and to grant an early allowance.

Respectfully submitted,

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EXHIBIT A



THE AMERICAN HERITAGE COLLEGE DICTIONARY

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